

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TRANSMISSION REPORT AND  
RECEIPT  
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CHOCTAW NATION OF OKLAHOMA,	:
	:
Opposer/Petitioner,	:
	:
v.	:
	:
MISSISSIPPI BAND OF CHOCTAW INDIANS,	:
	:
Applicant/Respondent.	:
	:
-----X	

	Cancellation No. 040730
	(Parent Case)
	Cancellation No. 040866
	Opposition No. 125682X
	Opposition No. 125905
	Opposition No. 125906
	Opposition No. 152088
	Opposition No. 152089
	Opposition No. 153592
	Opposition No. 153940
	Opposition No. 154289

**JOINT MOTIONS FOR CONSOLIDATION AND RESUMPTION OF PROCEEDINGS**

CHOCTAW NATION OF OKLAHOMA, Opposer/Petitioner herein, hereby moves pursuant to C.F.R. § 2.127(a) and Rule 42(a), Federal Rules of Civil Procedure, and TBMP § 510.03(b) for an order both consolidating and resuming all ten (10) of the above-identified proceedings, Cancellation Nos. 040730, 040866, Opposition Nos. 125682, 125905, 125906, 152088, 152089, 153592, 153940, and 154289 instituted before the Board.

I. Motion for Consolidation

Opposer/Petitioner well understands that the Board might not consider this or any similar motion for consolidation until answers are filed by Applicant/Respondent. Opposer/Petitioner, however, respectfully believes that the relevant facts and legal issues, as indicated below, provide sufficiently compelling bases to sooner consolidate the subject proceedings.

Opposer/Petitioner initiated the above-identified Cancellation proceeding No. 040730 on June 27, 2002, to prevent the registration by MISSISSIPPI BAND OF CHOCTAW INDIANS of the trademark CHOCTAW TIMES, the subject of Registration No. 2,459,782 covering "magazines featuring tribal news and events." In addition to Cancellation No. 040730, Opposer/Petitioner concurrently commenced the above-identified (1) Cancellation proceeding No. 040866 on June 27, 2002, against the service mark CHOCTAW MANUFACTURING ENTERPRISE, the subject of Registration No. 2,529,707 covering "custom assembly and manufacture of commercial wire harnesses, sockets and connectors, and automotive and non-automotive wiring and cable assemblies to the order or specification of others"; (2) Opposition proceeding No. 125682 on June 27, 2002, against the service mark CHI – CHOCTAW HOSPITALITY INSTITUTE, the subject of Application No. 76/365332 covering "employee training and education in the field of hotel, motel, restaurant, surveillance, security and casino management"; (3) Opposition proceeding No. 125905 on July 11, 2002, against the trade/service mark CGI – CHOCTAW GEO IMAGING, the subject of Application No. 76/365333 covering the goods, "computer programs for use in digital mapping" and the services "digital mapping"; (4) Opposition proceeding No. 125906 on August 16, 2002, against the service mark CHOCTAW RESORT DEVELOPMENT ENTERPRISE and Design, the subject of Application No. 76/365334 covering "resort management for others"; (5) Opposition proceeding No. 152088 on June 27, 2002, against the service mark CHOCTAW TOWN CENTER, the subject of Application No. 76/334068 covering "leasing of shopping mall space and commercial real estate development"; (6) Opposition proceeding No. 152089 on June 27, 2002, against the service mark CHAHTA ENTERPRISE, the subject of Application No. 76/334066 covering "custom manufacture of electrical wiring harnesses to the order and specification of others"; (7)

Opposition proceeding No. 153592 on August 16, 2002, against the trade/service mark CHOCTAW GEO IMAGING ENTERPRISE, the subject of Application No. 76/346302 covering the goods, "computer programs for use in digital mapping" and services, "digital mapping"; (8) Opposition proceeding No. 153940 on August 16, 2002, against the service mark CHOCTAW RESORT DEVELOPMENT ENTERPRISE, the subject of Application No. 76/334069 covering "resort management for others"; and (9) Opposition proceeding No. 154289 on September 20, 2002, against the service mark CHOCTAW HOSPITALITY INSTITUTE, the subject of Application No. 76/346301 covering "educational services, namely, conducting employee training and educational classes, seminars, conferences and workshops in the field of hotel, motel, restaurant, surveillance, security and casino management" all in the name of MISSISSIPPI BAND OF CHOCTAW INDIANS.

Rule 42(a) permits consolidation when common questions of law and fact are pending before the tribunal. In this instance, the parties in each proceeding are identical, the marks are confusingly similar, and the goods and services in and corresponding to the Applicant/Respondent's applications for (1) CHOCTAW MANAGEMENT SERVICES ENTERPRISE covering "personnel staffing and management services, computer information management, design, and implementation services", evidenced by Application No. 78/137856; (2) CHOCTAW CRAFTS AND BOOKS covering "retail store services, featuring paintings, books, crafts, clothing, key chains, quilts, jewelry, hair combs, barrettes, and novelty buttons", evidenced by Application No. 78/138266; (3) CHOCTAW INDIAN GAMING CENTER covering "providing casino services, namely, bingo and similar games of chance", evidenced by Application No. 78/138157; (4) CHOCTAW INN covering "hotel services", evidenced by Application No. 78/138190; (5) CHOCTAW TRAVEL PLAZA covering "professional truck

stop services, restaurant services, snack bars, public shower facilities, and motel services", evidenced by Application No. 78/138142; (6) CHOCTAW BINGO covering "providing casino services, namely, bingo and similar games of chance", evidenced by Application No. 78/138201; (7) CHOCTAW MANUFACTURING AND DEVELOPMENT CORPORATION covering "custom manufacture of military space heaters and containers for weapons shipments to the order and specification of others", evidenced by Application No. 78/137863; (8) THE GREAT SEAL OF THE CHOCTAW NATION and Design covering "publications", evidenced by Application No. 78/139345; and (9) CHOCTAW NATION HOSPITALITY HOUSE covering "providing social services programs for others, namely halfway house services", as evidenced by Application No. 78/139268; are closely related to Opposer/Petitioner's goods and services identified by its trademarks and service marks for and/or including CHOCTAW. It is apparent that the issues of law and fact involved in the cancellation and opposition proceedings are not only "common"; they are, in fact, virtually identical. Under these circumstances, it is in the interests of the parties and the Board to consolidate the ten (10) proceedings in order to permit the parties to present common briefs and testimony in each of the actions.

Trial dates have been not yet been officially set for the above referenced Cancellation and Opposition proceedings. In accordance with this motion for a consolidation of the proceedings, Opposer/Petitioner requests that trial dates for the consolidated proceedings be scheduled by notice issued from the Board.

## II. Motion for Resumption

On September 17, 2002, the Board issued an order suspending Cancellation No. 040730. On September 26, 2002, the Board issued an order suspending Opposition No. 152088. On October 1, 2002, the Board issued an order suspending Opposition No. 152089. On October 7,

2002, the Board issued an order suspending Opposition No. 125682. On November 26, 2002, the Board issued an order suspending Cancellation No. 040866. On December 9, 2002, Applicant/Respondent filed a motion to suspend the Opposition proceeding filed against Application No. 76/365334. The Board has not issued an order respecting this motion at this time. On March 5, 2003, the Board issued an order suspending Opposition No. 153940. On January 6, 2003, Applicant/Respondent filed a motion to suspend the Opposition proceeding filed against Application No. 76/346302. The Board has not issued an order respecting this motion at this time. On March 19, 2003, the Board issued an order suspending Opposition No. 125905. On March 21, 2003, the Board issued an order suspending Opposition No. 154289. Opposer/Petitioner requests resumption of these proceedings concurrent with the consolidation thereof. Contrary to the enclosed copy of counsel for Applicant/Respondent's STATUS REPORT TO BOARD IN SUSPENDED PROCEEDING (attached hereto as Exhibit A) filed with the Board on March 17, 2003, misrepresenting the status of the parties' settlement negotiations, any and all settlement negotiations were expressly terminated at least as early as March 14, 2003, as set forth in correspondence of Petitioner's/Opposer's counsel to Respondent's/Applicant's counsel dated March 17 and 25, 2003 (attached hereto as Exhibit B and C).

Respectfully submitted,  
Shulman Rogers Gandal Pordy & Ecker, P.A.  
Attorneys for Opposer/Petitioner

11921 Rockville Pike  
Third Floor - Rockville, Maryland 20852  
Tel.: (301) 230-5242 - Fax: (301) 230-2891

By: 

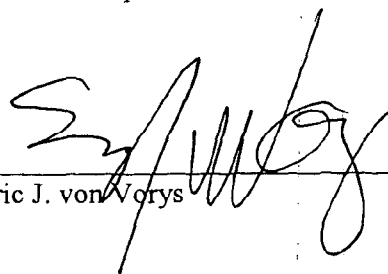
Eric J. von Vorys  
Stephen G. Janoski

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and complete copy of the foregoing JOINT MOTIONS FOR CONSOLIDATION AND FOR RESUMPTION OF PROCEEDINGS was served by first class mail, postage prepaid, this 26th day of March, 2003, upon Barbara L. (Pixie) Waite, Esquire, Venable, Baetjer, Howard & Civiletti, LLP, 1201 New York Avenue, N.W., Suite 1000, Washington, DC 20005, Attorney for Applicant/Respondent.

By: \_\_\_\_\_

Eric J. von Vorys

A handwritten signature in black ink, appearing to read 'E. von Vorys', is written over a horizontal line. The signature is stylized with a large 'E' and a long, sweeping tail.

## **EXHIBIT A**

This is Exhibit A, as referred to in the JOINT MOTIONS FOR CONSOLIDATION AND RESUMPTION OF PROCEEDINGS.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Trademark Trial and Appeal Board

In the Matter of U.S. Registration No. 2,459,782  
For: CHOCTAW TIMES  
Registered: June 12, 2001

CHOCTAW NATION OF OKLAHOMA

Petitioner,

vs.

Cancellation No. 040,730

MISSISSIPPI BAND OF CHOCTAW INDIANS


Registrant.

STATUS REPORT TO BOARD IN SUSPENDED PROCEEDING

Registrant, Mississippi Band of Choctaw Indians, hereby provides the Board with this Status Report further to its Order of September 16, 2002. Negotiations have been ongoing since that date and Registrant continues to believe that a resolution can be achieved between the parties.

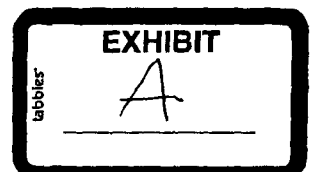
Respectfully submitted,

MISSISSIPPI BAND OF CHOCTAW INDIANS

By:   
Barbara L. (Pixie) Waite  
Venable, Baetjer, Howard & Civiletti, LLP  
1201 New York Avenue, NW., Ste. 1000  
Washington, DC 20005  
(202) 962-4811

Attorneys for Registrant

Dated: March 17, 2003



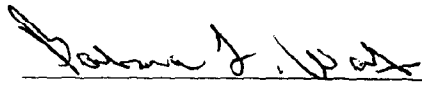
MAR 19 2003



CERTIFICATE OF SERVICE

I, Barbara L. Waite, hereby certify that a true and accurate copy of the foregoing Status Report has been served upon the following by U.S. Mail, postage prepaid, on this the 17<sup>th</sup> day of March, 2003.

Eric J. von Vorys  
Glenn C. Etelson  
Stephen G. Janoski  
Karl Wm. Means  
Shulman Rogers Gandal Pordy & Ecker, P.A.  
11921 Rockville Pike, Third Floor  
Rockville, Maryland 20852  
Attorneys for Petitioner

  
\_\_\_\_\_

dc2docs1\wp\441614

**EXHIBIT B**

This is Exhibit B, as referred to in the JOINT MOTIONS FOR CONSOLIDATION AND RESUMPTION OF PROCEEDINGS.

**SHULMAN  
ROGERS  
GANDAL  
PORDY &  
ECKER, P.A.**

Lawrence A. Shulman  
Donald R. Rogers  
Karl L. Ecker\*  
David A. Pordy\*  
David D. Freisheit  
Martin P. Schaffer  
Christopher C. Roberts  
Jeffrey A. Shanc  
Edward M. Hanson, Jr.  
David M. Kochanski  
James M. Kefauver  
Robert B. Canter  
Daniel S. Krakower  
Kevin P. Kennedy  
Alan B. Sternstein  
Nancy P. Regelin  
Samuel M. Spirito\*

Martin Levine  
Worthington H. Talcott, Jr.\*  
Fred S. Sommer  
Morton A. Faller  
Alan S. Tilles  
James M. Hoffman  
Michael V. Nakamura  
Jay M. Eisenberg\*  
Douglas K. Hirsch  
Ross D. Cooper  
Glenn C. Etelson  
Karl J. Protill, Jr.\*  
Timothy Dugan\*  
Kim Viti Fiorentino  
Sean P. Sherman\*  
Rebecca Oshway  
Ashley Joel Gardner

Michael J. Froehlich  
William C. Davis, III  
Paul A. Bellegarde\*  
Patrick M. Martyn  
Elizabeth A. White  
Sandy David Baron  
Christine M. Sorge  
Michael L. Kabik  
Gregory D. Grant\*  
Jeffrey W. Rubin  
Stephen G. Janoski  
Simon M. Nadler  
Karl W. Means  
Debra S. Friedman\*  
Matthew M. Moore\*  
Daniel H. Handman  
Robert S. Tanner

Eric J. von Vorys  
Michelle R. Curtis\*  
Gary I. Horowitz\*  
Jason M. Kerben  
Mark S. Guberman  
Cara A. Frye\*  
Sarit Keinan  
Mary Park McLean\*  
Heather L. Howard\*  
Stephen A. Metz  
Jude E. Wikremanyake  
Hong Suk "Paul" Chung  
Lisa C. DeLessio\*  
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Patrick J. Howley

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Michelle L. Lazerow\*  
*Maryland and D.C.*  
*except as noted:*  
\* Virginia also  
\* Maryland only  
\* D.C. only  
† Retired  
■ Federal practice only

Writer's Direct Dial Number:  
(301) 231-0956  
getelson@srgpe.com

March 17, 2003

*(Via Facsimile & Mail)*

**WITHOUT PREJUDICE**

Barbara L. (Pixie) Waite, Esquire  
Venable, Baetjer, Howard & Civiletti, LLP  
1201 New York Avenue, NW  
Suite 1000  
Washington, DC 20005

Re: Choctaw Nation of Oklahoma v. Mississippi Band of Choctaw Indians  
Our File No. 102593.00056

Dear Ms. Waite:

In response to your letter of March 17, 2003, the last I checked, what I have communicated to my client is confidential. I have no intent nor obligation to disclose to you what I have presented. As stated in my last letter, I find your position to be not unreasonable, but beyond reason. We will not agree to any suspension and will challenge each trademark.

Sincerely,

SHULMAN, ROGERS, GANDAL,  
PORDY & ECKER, P.A.

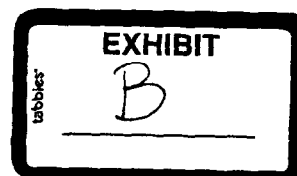
By: 

Glenn C. Etelson

GCE/ci

cc: Eric J. von Vorys, Esq.

GA127CMSE\WaiteLtr3-17-03.wpd



## **EXHIBIT C**

This is Exhibit C, as referred to in the JOINT MOTIONS FOR CONSOLIDATION AND RESUMPTION OF PROCEEDINGS.

# SHULMAN ROGERS GANDAL PORDY & ECKER, P.A.

Lawrence A. S.  
Donald R. Roge  
Karl L. Ecker  
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Martin P. Schaffer  
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*except as noted:*  
+ Virginia also  
+ Maryland only  
+ D.C. only  
+ Retired  
+ Federal practice only

Writer's Direct Dial Number:

(301) 231-0956  
getelson@srgpe.com

March 25, 2003

*(Via Facsimile & Mail)*

## WITHOUT PREJUDICE

Barbara L. (Pixie) Waite, Esquire  
Venable, Baetjer, Howard & Civiletti, LLP  
1201 New York Avenue, NW - Suite 1000  
Washington, DC 20005

Re: Choctaw Nation of Oklahoma v. Mississippi Band of Choctaw Indians  
Our File No. 102593.00056

Dear Ms. Waite:

On March 17, 2003, you misrepresented to the Board that negotiations were on-going. Negotiations ceased based on your insistence that we use tribal law, and we are moving forward to remove the suspensions from all of the opposition and cancellation proceedings. There are no pending discussions as you have represented. I sent you a letter confirming our phone call on this issue. Please do not represent to the board there are discussions. Your choice is to sign the agreement as it was sent or we will continue litigation.

Sincerely,

SHULMAN, ROGERS, GANDAL,  
PORDY & ECKER, P.A.

By: 

Glenn C. Etelson

GCE/

cc: Eric J. von Vorys, Esq.

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EXHIBIT

C

To: Assistant Commissioner for Trademarks  
U.S. Trademark Trial and Appeal Board

From: Shulman Rogers Gandal Pordy & Ecker, P.A.  
11921 Rockville Pike – Third Floor  
Rockville, MD 20852  
Tel. 301/230-5200

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**HAND FILED**

Shulman Rogers Filing Number 102593.00056

Filing Date March 26, 2003

<b>DEPOSIT ACCOUNT AUTHORIZATION</b> <u>X</u> Please debit any other charges or credit any overpayment to Deposit Acct No. 502211 and cite our Ref. No. <u>102593.00056-1</u>  Ingrid Mueller	Opposition/Cancellation No.: Cancellation No. 040730; Cancellation No. 040866; Opposition No. 125682; Opposition No. 125905; Opposition No. 125906; Opposition No. 152088; Opposition No. 152089; Opposition No. 153592; Opposition No. 153940; and Opposition No. 154289 Trademark: <u>CHOCTAW TIMES and Others</u> Client No. 102593.00056
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The following items/fees are submitted herewith to the U.S. Patent & Trademark Office:

**ITEMS**

- ☐ Transmittal Letter
- ☐ Response
- ☐ Amendment
- ☐ Notice of Opposition
- ☐ Petition to Cancel
- ☐ Request for Extension of Time to Oppose
- ☐ Answer to Notice of Opposition
- ☐ Withdrawal of Motion for Dismissal for Failure to Prosecute
- ☐ Stipulated Motion for Amendments to Applications and Notice of Withdrawal of Application
- ☐ Power of Attorney
- ☐ Notice of Appeal
- ☐ Change of Attorney's Address
- ☐ Notice of Withdrawal of Application
- ☒ Joint Motions for Consolidation and Resumption of Proceedings
- ☐ Stipulation of Dismissal

**U.S. PTO FEES ENCLOSED**

- X No Fee
- ☐ Extension Fee
- ☐ Notice of Opposition Fee
- ☐ Petition to Cancel Fee
- ☐ Notice of Appeal Fee

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**TOTAL FEES ENCLOSED**

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MARCH 27 AM 9:30